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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,258	12/09/2003	Gaku Ehara	031294	3331
23850 7590 01/25/2007 ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			EXAMINER TONGUE, LAKIA J	
			ART UNIT	PAPER NUMBER
			1645	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/730,258

Applicant(s)

EHARA ET AL.

Examiner

Lakia J. Tongue

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1, 3 and 4 is/are allowed.
- 6) ☐ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2006 has been entered.

Claims 1, and 3-5 are pending. Claim 1 has been amended. Claims 2 and 6 have been canceled. Claims 1, and 3-5 are under examination.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Theunis et al (Journal of Invertebrate Pathology, 1999; 73: 255-259).

Claim 5 is drawn to a control agent for Scarabaeidae insects containing as active ingredient sporangia of *Bacillus popilliae* containing spores and parasporal bodies obtained by the production process according to claim 1 (producing sporangia of

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Bacillus popilliae containing spores and parasporal bodies comprising the steps of culturing *Bacillus popilliae* in a medium containing an adsorbent and 0.2-4.0% by weight of free glutamic acid so that the ratio of free glutamic acid to total amino acids contained in the medium is within the range of 35 to 90% by weight, and recovering the sporangia from the medium).

Theunis et al disclose an application of spores and parasporal bodies from *B. popilliae* (see page 257; *B. popilliae* isolates). Moreover, the application caused concentrated mortality in both second and third instars (see page 257; Food Application). Lastly, Theunis et al disclose that *Bacillus popilliae* plays a major role in biological control of scarabaeidae insect (see page 255; 2nd column; 4th paragraph).

It should be remembered that the products of the prior art reference appear to be the same as the product claimed by the applicant because they appear to possess the same or similar functional characteristics, i.e. insecticidal activity. The purification or production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This is particularly true when the process does not change properties of the product in an unexpected manner. See In re Thorpe, 227 USPTO 964 (CAFC 1985); In re Marosi, 218 USPTO 289, 29222-293 (CAFC 1983); In re Brown, 173 USPTO 685 (CCPA 1972). Even if applicant's product can be shown to be of higher purity than the product of the prior art reference, applicant needs to show some unexpected and unique utility or property, such as unexpected biologically significant increase in specific activity with which the increased purity, great stability and/or practicality or freedom from some

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restrictive element or adverse side effects inherent in the product preparations of the prior art or some other secondary consideration which the additional degree of purity imparts to applicants product in order to overcome the aspect of the product's purity.

2. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka et al (U.S. 2006/0090220 A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim 5 is drawn to a control agent for Scarabaeidae insects containing as active ingredient sporangia of *Bacillus popilliae* containing spores and parasporal bodies obtained by the production process according to claim 1 (producing sporangia of *Bacillus popilliae* containing spores and parasporal bodies comprising the steps of culturing *Bacillus popilliae* in a medium containing an adsorbent and 0.2-4.0% by weight of free glutamic acid so that the ratio of free glutamic acid to total amino acids contained in the medium is within the range of 35 to 90% by weight, and recovering the sporangia from the medium).

Tanaka et al disclose a control agent comprising polypeptides in combination with spores or sporangia containing spores and parasporal bodies of bacteria belonging

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to *Bacillus popilliae*, which can further increase larvae growth inhibition or insecticidal activity on Scarabaeidae insects (see paragraph 0050).

It should be remembered that the products of the prior art reference appear to be the same as the product claimed by the applicant because they appear to possess the same or similar functional characteristics, i.e. insecticidal activity. The purification or production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This is particularly true when the process does not change properties of the product in an unexpected manner. See *In re Thorpe*, 227 USPTO 964 (CAFC 1985); *In re Marosi*, 218 USPTO 289, 29222-293 (CAFC 1983); *In re Brown*, 173 USPTO 685 (CCPA 1972).

Even if applicant's product can be shown to be of higher purity than the product of the prior art reference, applicant needs to show some unexpected and unique utility or property, such as unexpected biologically significant increase in specific activity with which the increased purity, great stability and/or practicality or freedom from some restrictive element or adverse side effects inherent in the product preparations of the prior art or some other secondary consideration which the additional degree of purity imparts to applicants product in order to overcome the aspect of the product's purity.

Since the Office does not have the facilities for examining and comparing applicants' composition with the composition of the prior art, the burden is on applicant to show a novel or unobvious difference between the claimed product and the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 205 USPQ 594.

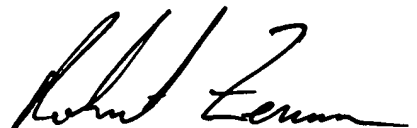
Conclusion

3. Claim 5 is rejected. Claims 1, 3, and 4 are allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakia J. Tongue whose telephone number is 571-272-2921. The examiner can normally be reached on Monday-Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


LBT
1/17/07


ROBERT A. ZEMAN
PRIMARY EXAMINER